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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/613,006	07/10/2000	Mark A. Schena	M-9216 US	9156

24251 7590 12/12/2001

SKJERVEN MORRILL MACPHERSON LLP  
25 METRO DRIVE  
SUITE 700  
SAN JOSE, CA 95110

EXAMINER
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FORMAN, BETTY J

ART UNIT	PAPER NUMBER
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1655

DATE MAILED: 12/12/2001

60

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/613,006

Applicant(s)

SCHENA, MARK A.

Examiner

BJ Forman

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 03 December 2001 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached Continuation of Advisory Action.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1 and 3-26.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: PTOL-206 and Interview Summary



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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
09/613, 006	10 July 2000	Schena	M9216-US

EXAMINER	
B FORMAN	
ART UNIT	PAPER NUMBER
1655	10

DATE MAILED:

The decision on the petition filed in the above entitled application is as follows:

☐ Delay in Prosecution Held Unavoidable (35 U.S.C. 133),  
Petition Granted \_\_\_\_\_

☐ Delayed Payment of Issue Fee Accepted (35 U.S.C. 151),  
Petition Granted \_\_\_\_\_

☒ Petition Granted 37 CFR 1.84(b)(2)

☐ Petition Denied \_\_\_\_\_

☐ Petition Dismissed \_\_\_\_\_

By direction of the Deputy  
Assistant Commissioner for Patents

W. Gary Jones  
Supervisory Patent Examiner  
Technology Center 1600



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**Continuation of Advisory Action**

Applicant argues that one of skill in the art would understand that the claimed "synthetic oligonucleotides" refers to oligonucleotides prepared by chemical synthesis and because Lashkari et al. do not teach chemically synthesized oligonucleotides, they do not anticipate the claimed invention. Additionally, Applicant argues that the examiner has misconstrued the term "synthetic oligonucleotide" by citing one of three definitions provided by Academic Press. The arguments are not found persuasive for the reasons stated in the previous action i.e. because "synthetic" as defined by Academic Press Dictionary of Science and Technology (Morris, C. ed. Academic Press, 1992, page 2157) means "any product or item that is the result of human technology rather than something that exists in nature". It is noted that the Academic Press Dictionary provides three definitions one of which is quoted above and is referred by the dictionary as an engineering definition. The **first** definition provided by the dictionary is referred to as the **science** definition which recites "relating to, produced by, or involving synthesis." The second definition provided by the dictionary is referred to as the chemistry definition which recites "relating to compounds formed artificially by chemical synthesis." Therefore, given the three similar definitions of "synthetic" provided, the labeled cDNA and the labeled genomic DNA both of which are produced by synthesis; both of which are the result of human technology; both of which do not exist in nature; and both of which are artificially formed are, according to standard scientific definitions and terminology, "synthetic". Therefore, the labeled cDNA and labeled genomic DNA of Lashkari et al. are encompassed by the claimed "synthetic oligonucleotides".

Applicant provides two descriptions of chemically synthesized oligonucleotides wherein the chemically synthesized oligonucleotides are referred to as synthetic oligonucleotides. While the references illustrate that chemically synthesized oligonucleotides are "synthetic oligonucleotides", the references do not define chemically synthesized oligonucleotides as the only form of "synthetic oligonucleotides". Additionally, the references do not teach that "synthetic oligonucleotides" are only chemically synthesized oligonucleotides and they do not teach that labeled cDNA and labeled genomic DNA are not "synthetic oligonucleotides".

Applicant further argues that cDNA and genomic DNA of Lashkari et al. not properly described as oligonucleotides because it was known in the art that oligonucleotides are generally 50 nucleotides or less. This argument is not found persuasive because while Lashkari et al. is silent regarding the length of their probes, they teach their cDNA and genomic DNA are synthesized by primer extension (page 13058, left column first and second full

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paragraphs) which inherently produces fragments of various sizes. Therefore, their synthesized cDNA and genomic DNA probes inherently includes oligonucleotides of 50 nucleotides or less.

Applicant argues that the cDNAs of Brown et al. are distinguishable from the claimed synthetic oligonucleotides for the reasons discussed above regarding the Lashkari et al. reference. The arguments have been considered, but are not found persuasive for the reasons stated above regarding Lashkari et al.

Applicant further argues that Wang et al. and Fodor et al. do not remedy the defects of Brown et al. The argument is not found persuasive for the reasons stated above i.e. the labeled cDNAs of Brown et al. are encompassed by the claimed "synthetic oligonucleotides".

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BJ Forman whose telephone number is (703) 306-5878. The examiner can normally be reached on 6:45 TO 4:15.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones can be reached on (703) 308-1152. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 308-8724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

BJ Forman, Ph.D.  
Patent Examiner  
Art Unit: 1655  
December 6, 2001

*S. Etoman*